REMARKS

Claims 1 – 18 are pending in the application. Claims 1 – 18 have been rejected. Claim 19 has been added.

Examiner Interview

The undersigned wishes to thank Examiner Jean Gilles for the constructive telephone interview conducted on August 25, 2005. In that telephone interview, Examiner Jean Gilles provisionally agreed that Boyd and Barg track 100% of the tracking data and that server-side data analysis is performed to create subpopulations after the data has already been collected and stored. If true, the Examiner agreed that Boyd and Barg would not create the advantages of the present application of reducing web traffic overhead and processing by tracking less than 100%, and that the claims would comprise allowable subject matter. The Examiner indicated that a further search may be necessary to confirm this. The Examiner further provisionally agreed that a simple cookie as described in the Barg patent is not equivalent to the intent and operation of a "selection indicator" which by claim 1 is stored on the visitor computer. The selection indicator is associated with inclusion or non-inclusion within a sample group, where non-inclusion results in a traffic analysis server ignoring the traffic activity from the visitor computer thus resulting in reduced overhead at the traffic analysis side. The Examiner has suggested that the specifics of the claim elements not shown in the prior art of record be detailed in the response, which is included below.

Claim Rejections – 35 U.S.C. § 112

Claim 1 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter of the claimed invention. In particular, the Examiner has objected to the phrase "visitor computer and/or visitor" as not distinctly claiming subject matter.

The application makes clear that the invention is interested in tracking visitors to particular web sites through a sampling process where not all visits are tracked in order to reduce the data necessary to send through the Internet to the tracking server. The application further makes clear that while accesses from particular visitor computers may be tracked, that it is possible to also track individuals through their profiles on that computer (see, *e.g.*, page 10, line 5+).

The invention is applicable both for sampling individual users of the computers as well as the computers themselves. Accordingly, claim 1 has been amended to recite "visitor computer" which, as stated on page 10, lines 13-15, is defined as "not intended to be limited to any single machine but rather could encompass selection of the machine itself and/or the visitor currently operating the machine."

In light of this amendment, therefore, removal of this rejection to claim 1 is respectfully requested.

Claim Rejections – 35 U.S.C. § 103

Claims 1 – 18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,360,261 (Boyd, et al.) in view of U.S. Publication No. 2002/0070953 (Barg, et al.).

This rejection is traversed on two grounds: namely that (1) it would not be obvious to combine the teachings of Boyd and Barg to provide the present invention as claimed because the purpose of the present invention is not achieved by such combination, and (2) Boyd and Barg, even if combined, do not teach each and every element of the claims.

    1. Applicable Law Concerning §103(a) Rejections

The Federal Circuit has been consistent in reversing the PTO when a rejection is made on the basis of hindsight, that is, when an Examiner rejects the application under 35 U.S.C. §103(a) grounds as obvious under a combination of two or more patents without any specific suggestion within the patents to combine the features. In re Rouffett, 47 USPQ2d 1453 (Fed. Cir. 1998), the Federal Circuit refused to uphold an obviousness rejection, even where skill in the art is high, absent the specific identification of principal, known to one of ordinary skill in the art that suggests the claimed combination.

The Federal Circuit reemphasized the care to be taken when combining prior art references in obviousness findings in Ecolochem v. Southern Cal. Edison, 56 USPQ2d 1065 (Fed. Cir. 2000), stating that such absence of evidence to combine prior art references "is defective as hindsight analysis." The Federal Circuit held similarly in In re Kotzab, 55 USPQ2d 1313 (Fed. Cir. 2000), reversing the PTO and stating that, "[i]dentification of prior art statements that, in abstract, appear to suggest claimed limitation does not establish prima facie case of obviousness without finding as to specific understanding or principal within knowledge of skilled artisan that would have motivated one with no knowledge of the invention to make the combination in the manner claimed."

Finally, the Federal Circuit has reaffirmed their view that the PTO used improper hindsight analysis to reject patent claims under §103(a) in the recent case of In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), stating that a specific suggestion in the prior art cited is required and not a simple citation to "common knowledge and common sense." Lee includes a tour-de-force of case law directed to the issue of combining references including those as follows:

- "The factual inquiry whether to combine references must be thorough and searching. . . . It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with." (Lee, 277 F.3d at 1343)

- "A showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding." (quoting Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000)

- "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis if rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." (quoting C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)

- "There must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant." (quoting In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)

- "Teachings of references can be combined only if there is some suggestion or incentive to do so." (quoting In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (emphasis in original)

The Patent Office has failed to display the rigor required by the Federal Circuit holdings in demonstrating a suggestion within the art that the cited prior art references should be combined.

2. *One Would Not be Motivated to Store on the Visitor Computer a Selection Indicator Associated with the Inclusion or Non-Inclusion [of the visitor computer]*

Boyd teaches methods for analyzing traffic data from traffic data hits received at an analysis server. The analysis is strictly server side. That is, all hits received at the traffic analysis server are recorded in tables. A user can then subsequently parse the data stored within the tables in order to access and categorize relevant information. This means that 100% of the traffic data is received and sorted by the analysis server. By use of the selection indicator as implemented within the present invention, however, less than 100% of the traffic data is received and processed thus leading to a reduced overhead—a problem not addressed in Boyd.

The Examiner makes reference to this server-side sampling/parsing when citing to the portion of the Boyd patent where a California visitor can be parsed within a new record to differentiate the visit from the 5 user sessions originating from Texas. Again, 100% of the visitors are tracked and data representing each hit of the 6 visitors are transmitted over the Internet to the analysis server. Since 100% of the traffic information is sent to the analysis server, no filter in the first instance is implemented to reduce the amount of traffic sent to the analysis server and processing required to store it.

It is clear that Boyd teaches that "each traffic data hit" is collected (see, *e.g.*, Boyd Abstract) in order to obtain as accurate and comprehensive information as possible about the web site traffic pattern and demographics of its visitors. (see, *e.g.*, Boyd, Col. 6, line 46 to Col. 7, line 21) Boyd does not address the problem of increased resources (Application, page 2, lines 4-5) required to handle increased data reporting from visitor computers during increased traffic. Boyd does not include the word "sampling", does not address the concept of traffic sampling, and in fact only teaches the analysis techniques applied to all hits received on the server side. Accordingly, one knowledgeable in the art would not be motivated to look for a solution involving the teachings of the Boyd reference. That is, since Boyd handles all traffic information, there would be no need to store on the visitor computer a selection indicator since none would be necessary—all information is instead tracked at the server.

3. *Not All Features of the Pending Independent Claims are Taught in the Combination of Boyd and Barg*

The Boyd and Barg references do not teach several key elements of the claimed invention, *inter alia*, the steps of (a) storing on the visitor computer a selection indicator associating with the inclusion or non-inclusion, (b) tracking traffic activity to the web site . . . only if the visitor computer is a member within the sample group, (c) said cookie value including a visitor selection value, and (d) returning the web page and data mining code to a visitor computer if part of a sample group, otherwise returning just the web page.

(a) *Storing a Selection Indicator [claim 1]*

Turning first to the issue of a selection indicator, no such indicator is specified in Barg as part of the cookie information stored on the visitor computer responsive to a web site visit. Barg does teach in paragraphs 90-92 that cookies can be transmitted with a web page and stored on the visitor computer. Barg further teaches that the cookie is transmitted back to the web server along with the request for a new web page so that the visitor computer can be tracked as it browses through the visited web site. The Barg cookie acts no more than an identifier. There is no indication within Barg that the cookie is associated with the visitor computer's inclusion or non-inclusion within a sample group.

The cookie value in Barg is set well before the data is analyzed and parsed at the data analysis server. Claim 1 has been amended to clarify that the selection of the visitor computer occurs before the selection indicator is stored. There is clearly no such feature within Barg since one cannot tell from analyzing data at the visitor computer using the Barg cookie whether the visitor computer is to be part of a subpopulation during the data analysis step. That is, Barg simply sets a cookie value and tracks visitors from that computer under that cookie value number. Only after visitor machines have been identified by the Barg cookie does one perform a data analysis.

(b) *Tracking Only if Within Sample Group [claim 1]*

The Examiner cites to Boyd col. 7, lines 1-21 as teaching the limitation of tracking the traffic activity only if the visitor computer is a member within the sample group, otherwise ignoring the traffic activity. Boyd teaches the server-side processes of parsing traffic data. However, ALL such data is tracked and stored. That is, even if the user of the Boyd analysis tool is interested in finding out the number of California visitors, those visitors from other states are still tracked—it's just that such information would not appear in the parse function. Accordingly, the stated goal of the present invention of limiting traffic activity to the data

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analysis server and related subsequent processing from handling 100% of the web site visits would not be solved by the Boyd process of tracking all data regardless of inclusion or non-inclusion within the sample group.

(c) Cookie Selection Value [claim 10]

While true that Barg implies a cookie value—that is, an ID value attached to the visitor computer and associated with the web site visit data from that computer—meaningful limitations cannot be ignored. Barg does not teach the use of a cookie having a visitor selection value, especially where the value is set to "true" [claim 12] thus indicating inclusion within the sample group. Barg simply teaches a cookie ID value that is associated with data stored within the data analysis tool. Operation of the data analysis tool to form subpopulations of visitors during data analysis is not equivalent to making the cookie ID number a visitor selection value.

(d) Operating or Not Operating the Data Mining Code [claim 15]

Boyd and Barg appear to track and store all information from all visits to a web site. There is no traffic sampling in the first instance to reduce the traffic flowing to the data analysis server. Accordingly, there would be no differentiating between operating or not operating the data mining code on the visitor computer—Boyd and Barg require that the data mining code ALWAYS operate. But claim 15 goes further in that it requires that data mining code be only sent to the visitor computer if the visitor computer is determined to be a member of the sample group; otherwise just the web page is sent. In this way, the data sent to the non-included visitor computer may be reduced as not including the data mining code. In Barg, the inclusion of the visitor computer within the subpopulation during data analysis is not known until after the web page has been send and the traffic from that computer tracked. There would be no motivation within Barg to send less than the web page and any associated data mining code.
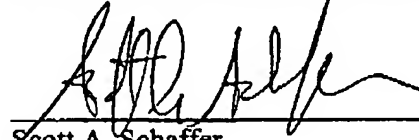
As Boyd and Barg do not collectively teach the above limitations, rejection under §103(a) would be improper. Furthermore, as Boyd and Barg receive all traffic data, there would be no need to normalize the data to correct for the sample group size [claims 9 and 19]. Accordingly, reconsideration of the rejections and allowance of all claims is respectfully requested.

CONCLUSION

For the foregoing reasons, reconsideration and allowance of claims 1 - 18 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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